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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/087,136	05/28/1998	H. ROBERT HORVITZ	01997/202002	9188

7590

03/26/2002

KRISTINA BIEKER BRADY
CLARK & ELBING
176 FEDERAL STREET
BOSTON, MA 02110

EXAMINER

CANELLA, KAREN A

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/087,136

Applicant(s)
Horovitz et al

Examiner
Karen Canella

Art Unit
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jan 8, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Jan 8, 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☒ Applicant's reply has overcome the following rejection(s):
see attached
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: none
Claim(s) objected to: none
Claim(s) rejected: 1, 4-7, 10-18, and 25
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 22
11. ☐ Other:

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Response to Arguments

1. Claims 1, 4-7, 10-18 and 25 are under consideration.

2. In view of the papers filed January 18, 2002, the inventorship in this nonprovisional application has been changed by the deletion of Craig Ceol.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.


3. The rejection of claims 1, 4-7, 10-18 and 25 under 35 U.S.C. 101 for lacking a specific, substantial and credible utility is maintained for reasons of record. Applicant argues that the utility of the disclosed C elegans peptides has been established by the teachings of the specification on page 2, lines 5-12 which states that the disclosed peptides are important in Ras-type signal transduction in the sexual differentiation of C elegans, and mutated Ras genes in humans have been associated with a broad range of human cancers. Applicant has provided an additional reference by Hunter et al to set forth the correlation between Ras gene mutations and cancer. This has been considered but not found persuasive. The claimed polypeptides are biologically active in the sexual differentiation of C elegans. There is no objective evidence or any art of record to support the allegation that the claimed polypeptides would be therapeutic in the treatment of cancer or any other human disease.

4. The rejection claims 1, 5, 15 and 25 under 35 U.S.C. 102(a) as being anticipated by Lu and Horvitz (June 1996 meeting) is withdrawn. The rejection of claims 1, 3, and 5 under 35 U.S.C. 102(a) as being anticipated by Ceol and Horvitz (June 1996 meeting) is withdrawn.

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Rejection of claims 1,3,5,11,14-16 under 35 U.S.C. 102(a) as being anticipated by Lu and Horvitz (May 1997 meeting) is withdrawn. The rejection of claim 25 under 35 U.S.C. 102(a) as being anticipated by Ceol and Horvitz (May 1997 meeting) is withdrawn.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

March 16, 2002